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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,841	07/25/2003	Perry W. Auger	005127.00247	9271
22907	7590	01/12/2005		
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			EXAMINER KAVANAUGH, JOHN T	
			ART UNIT 3728	PAPER NUMBER

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/626,841	AUGER ET AL.	
	Examiner	Art Unit	
	Ted Kavanaugh	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-22 and 25-28 is/are rejected.
- 7) ☒ Claim(s) 12, 23, 24, 29-38 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/12/04&2/19/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the lining (76) covering the padded collar element (74), claims 7 and 34, must be shown or the feature(s) canceled from the claim(s). Figure 14 as described in the specification doesn't accurately show this feature. It would appear from the figure that the padding and the lining, the lateral and medial portions are one continuous element. No new matter should be entered. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,5 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4574498 (Norton et al).

Norton teaches an article of footwear comprising a cleat assembly, a cushioning midsole (22,34), and an upper (12) bonded to the cushioning midsole. The midsole is bonded by a rivet 29 or any another conventional manner as well, see col. 2, lines 62-65. The footwear of Norton lacks a “full-length lasting board” as claimed.

4. Claims 9-11,13-19,25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6499235 (Lussier et al).

Lussier teaches an article of footwear comprising a cleat assembly, the cleat assembly comprising a base (sole 2) having a connecting matrix (plates 4,6), a plurality of ground engaging elements (16,18), a medial support bar (22), and a lateral support bar (20) wherein the medial stiffened section of the medial support bar is thicker than the lateral stiffened section (see figures 6 and 7 which

show the bars shown in cross-section with the medial side thicker than the lateral side). The medial section is thicker and therefore is naturally stiffer than the lateral stiffened section. Regarding claims 14-16, the support bars (20,22) are visible through a transparent window (5) located in the connecting matrix (4). Regarding claim 18, the support bars (20,22) are made of a very stiff material including glass fiber reinforced plastic, see col. 6, lines 6-27, and therefore are stiffer than the base. Regarding claim 19, stability element (24,26) represents a supplemental stiffening element.

Claim Rejections - 35 USC 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2,4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norton '498.

Norton teaches footwear as claimed except for the midsole being made out of heated and compressed EVA foam. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the midsole of Norton out of a EVA foam, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Regarding the foam being heated and compressed, this

limitation is a product by process limitation and it is well settled that the patentability of a product ordinarily cannot depend on its method of being made. See In re Thorpe, 777 F.2d 695, 227 USPQ 964 (1985). The method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. Moreover, "Product-by-Process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps", MPEP 2113.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 2 above, and further in view of US 4914838 (Ihlenburg).

Ihlenburg teaches an air cushion (20; see col. 3, lines 63-68) used in the heel region between the upper and the midsole (base member 12). It would have been obvious to provide the footwear of Norton with a heel cushion, as taught by Ihlenburg, to provide better cushioning characteristics.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norton in view of US 6167640 (Schafer).

Norton teaches footwear as claimed except for the upper comprising a peripherally stitched Strobel sock. Norton teaches the upper and the sole attached by rivets (29) or any other conventional manner as well, see col. 2, lines 62-65. Schafer, in the background of the invention, teaches the method known as the Strobel lasting method which involves stitching an insole (sock) to the upper, see col. 1, lines 34-44. It would have been obvious to provide the upper of Norton with a stitched Strobel sock, as taught by Schafer, to provide a more secure structure.

9. Claims 7,8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norton in view US 6018891 (Duclos).

Norton teaches footwear as claimed except for the footwear comprising a lining covering the padded collar element (18) and the inside portion of the footwear. Duclos teaches a footwear wherein the footwear comprises a lining (32) covering the padded collar element and the inside portion of the shoe. It would have been obvious to provide the footwear of Norton with a lining covering the padded collar and the inside of the footwear, as taught by Duclos, to provide additional comfort to the wearer. Regarding the padded collar element padded with closed cell foam. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the padding out of closed-cell foam, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

10. Claims 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lussier et al in view of Ihlenburg '838.

Lussier teaches footwear as claimed except for the footwear comprising a cross-sole flexure region. Ihlenburg teaches footwear wherein the sole and base member include a cross-sole flexure region (56,58) in the forefoot region. It would have been obvious to provide the sole of Lussier with a cross-sole flexure region in the forefoot section, as taught by Ihlenburg, to permit the sole to bend in this region.

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lussier '235.

Lussier teaches footwear as claimed except for the supplemental stiffening element (24,26) comprising a nickel-titanium alloy strip. Lussier teaches the stability element is made out of relatively stiff material; see col. 6, lines 15-27. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the element out of nickel-titanium alloy strip or other suitably stiff material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

12. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lussier '235 in view of Norton '498.

Lussier teaches footwear as claimed except for the cleat assembly is open in at least a midfoot region. Norton teaches the cleat assembly with an opening (24f) in the midfoot region. It would have been obvious to provide the cleat assembly of Lussier with a central opening, as taught by Norton, to provide a lighter shoe.

Allowable Subject Matter

13. Claims 12,23,24,29-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.


15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 (FORMAL FAXES ONLY). Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 3:45PM.

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Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
January 7, 2005